



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,478	10/02/2006	Andrew D. Hamilton	Y03-104US Nat	6687

28156 7590 02/04/2008
COLEMAN SUDOL SAPONE, P.C.
714 COLORADO AVENUE
BRIDGE PORT, CT 06605-1601

EXAMINER

CHO, JENNIFER Y

ART UNIT	PAPER NUMBER
----------	--------------

1621

MAIL DATE	DELIVERY MODE
-----------	---------------

02/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/588,478	Applicant(s) HAMILTON ET AL.	
	*Examiner Jennifer Y. Cho	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 5,6,9-12,14,16,17,19,21 and 23-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7-8, 13, 15, 18, 20, and both claims numbered 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/18/07</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

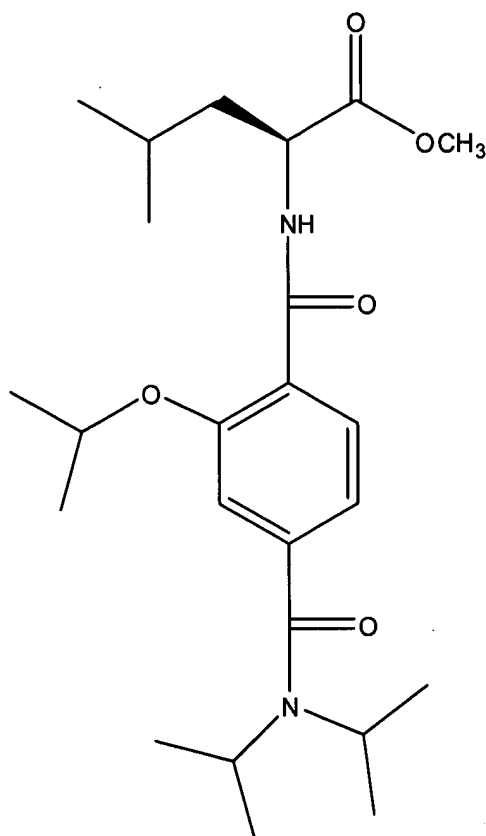
Receipt is acknowledged of the Response filed 11/23/2007.

Claims 1-33 are pending in this application.

Applicant's election of Group 1, claims 1-22, with traverse, in the reply filed on 11/23/07 is acknowledged. The traversal is on the ground(s) that the Office Action has not established that it would pose an undue burden to examine the full scope of the claims. This is not found persuasive because the claims of the various groups are divergent in subject matter and are classified separately. The requirement is still deemed proper and is therefore made FINAL.

Claims 23-33 are withdrawn from consideration, being drawn to the non-elected subject matter.

Applicant's election of the following compound is acknowledged herewith:



Thus, additionally, claims 5-6, 12, 16-17, 19 and 21 are hereby withdrawn from consideration being non-readable on the elected species. Accordingly, the claims have been examined solely to the extent of the elected species.

IDS

The information disclosure statement (IDS) filed on 5/18/07 is acknowledged. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Objections

Content of Specification

- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

Content of specification is missing cross-references to related applications.

Appropriate correction is required.

Claim Objections

Claims 22 and 22' are objected to because of the following informalities: There are two claims numbered 22. Appropriate correction is required.

Claim 7 is objected to because of the following informalities: It is unclear what is meant by the wording "form a hydrogen bond". The Examiner suggests the alternate wording, "is H". Appropriate correction is suggested.

Claim Rejections – 35 USC 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

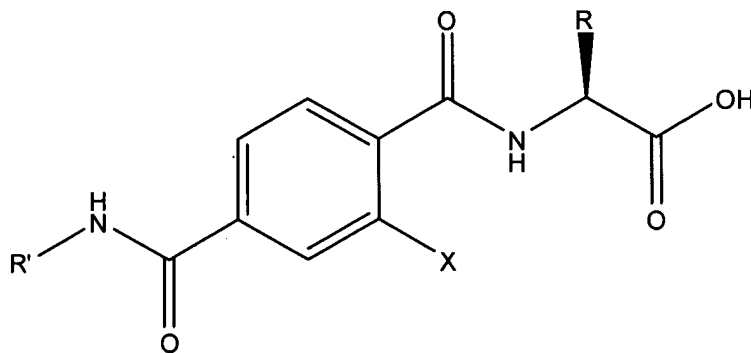
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-8, 13, 15, 18, 20, and both claims numbered 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Burdick (WO 99/49856).

The instant claims are drawn to terephthalamide peptidomimetic compounds represented by formula (1) as depicted in claim 1.

Burdick teaches terephthalamide peptidomimetic compounds (page 141, example 297; page 142, examples 303-305; page 143 and 144, examples 308-312; page 147, examples 340-354; page 148, examples 355-357, 359-362; page 149, examples 363-366; page 150, example 367-368; page 151, example 378; page 152, example 379), with the general structure found below:



These compounds can be used in pharmaceutical compositions with a pharmaceutical additive (page 10, lines 8-14; page 61, lines 4-6, 26-34). Therefore these claims are fully met.

Claim Rejections - 35 USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

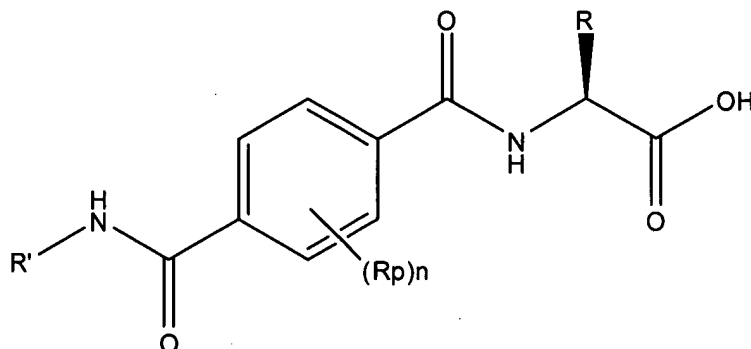
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 7-11, 13-15, 18, 20 and both claims numbered 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burdick (WO 99/49856).

The instant claims are drawn to terephthalamide peptidomimetic compounds represented by formula (1) as depicted in claim 1.

Burdick teaches a genus of terephthalamide peptidomimetic compounds (page 10, lines 30-31; page 18, lines 7-8), with the general structure found below, including specific examples (page 141, example 297; page 142, examples 303-305; page 143 and 144, examples 308-312; page 147, examples 340-354; page 148, examples 355-357, 359-362; page 149, examples 363-366; page 150, example 367-368; page 151, example 378; page 152, example 379). Specifically, Burdick teaches the benzene ring can be substituted with alkoxy groups (page 20, line 12; page 21, line 20).



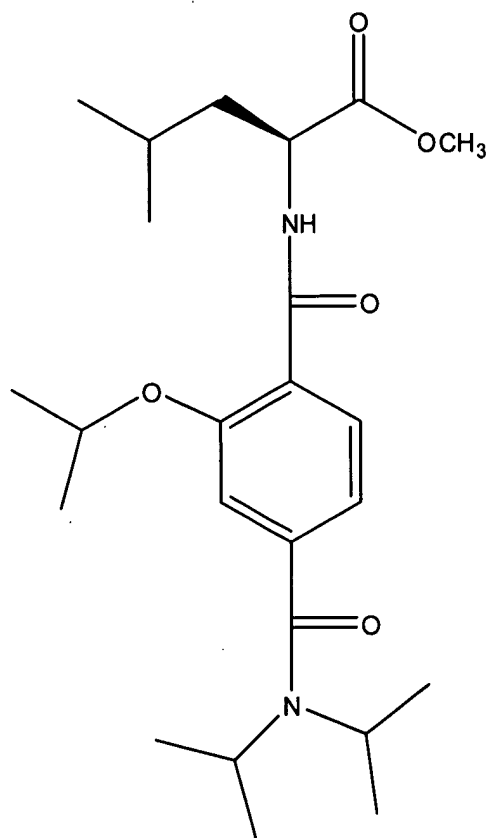
These compounds can be used in pharmaceutical compositions with a pharmaceutical additive (page 10, lines 8-14; page 61, lines 4-6, 26-34).

Burdick is deficient in that it does not exemplify alkoxy substituents on the benzene ring.

However, it would be prima facie obvious to one of ordinary skill in the art at the time of the invention, to determine the appropriate chemical constituents from Burdick's genus structural limitations, including substituting an alkoxy group on the benzene ring, to arrive at Applicant's compounds. The prior art teaches the generic, while Applicant teaches the species. One of ordinary skill in the art would have been motivated to make permutations of the variable groups within Burdick's genus structure, with the reasonable expectation that the compounds would be useful to treat immune response disorders. Absent any unusual and/or unexpected results, it is the Examiner's position that the teaching of the generic concept is obvious over the teaching of Applicant's species, because the same product is produced and the art recognizes the species as equivalent. The expected result would be the efficient production of terephthalamide peptidomimetic compounds for the pharmaceutical industry.

Allowable Subject Matter

Applicant's elected species, drawn below, appears to be free of prior art.



The search was extended to the point to where patentability can be determined with respect to the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Y. Cho whose telephone number is (571) 272 6246. The examiner can normally be reached on 9 AM - 6 PM.

Application/Control Number:
10/588,478
Art Unit: 1621

Page 9

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached on (571) 272 0871. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jennifer Cho
Patent Examiner
Art Unit: 1621

A handwritten signature in black ink, appearing to read 'Yvonne Eyler', with a horizontal line drawn underneath it.

Yvonne Eyler
Supervisory Patent Examiner
Technology Center 1600